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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/114,973 07/14/98 DOVE

W 960296.95491

EXAMINER

HM22/0816

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FORMAN, B

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

08/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/114,973

Applicant(s)

William F. Dove

Examiner

BJ Forman

Group Art Unit
1655



☒ Responsive to communication(s) filed on Jul 14, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-25 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, 11-16 & 25, drawn to a method to identify segregating mutations, classified in class 800, subclass 22.
 - II. Claims 7-9, drawn to a method to identify mutations following treatment with mutagens, classified in class 435, subclass 441.
 - III. Claim 10, drawn to a method to identify a human genetic sequence corresponding to a segregating mutation, classified in class 935, subclass 77.
 - IV. Claims 17-18, drawn to a genetically altered mouse, classified in class 800, subclass 9.
 - V. Claims 19-24, drawn to a non-human animal with segregating mutations, classified in class 800, subclass 8.
2. Inventions I and II & III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation because they are methods having different method steps, different functions, different effects and because they have a different results such as identification of segregating mutations (invention I), identification of mutations following mutagenic treatment (invention II), and identification of human genetic sequence (invention III).
3. Inventions I-III and IV & V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as

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claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as micro injection.

4. Inventions II & III and IV & V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different method steps and different effects as stated above.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Bennett J. Berson on August 6, 1999 to request an oral election to the above restriction requirement. Mr. Berson requested a written restriction be mailed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman, Ph.D. whose telephone number is (703) 306-5878. The examiner can normally be reached on Monday through Thursday and alternate Fridays from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152. The official FAX phone number for this group is (703) 308-4242. The unofficial FAX number is (703) 308-8742. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

BJ Forman

August 11, 1999

S. Zitomer
STEPHANIE W. ZITOMER
PRIMARY EXAMINER